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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,503	12/06/2000	Edward Neil Chapman	10432/29	1242

1333   7590   06/03/2005

PATENT LEGAL STAFF
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EXAMINER
BURLESON, MICHAEL L

ART UNIT	PAPER NUMBER
2626	

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
09/731,503</td><td>Applicant(s)
CHAPMAN, EDWARD NEIL</td></tr>
<tr><td>Examiner
Michael Burleson</td><td>Art Unit
2626</td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-20* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☒ Other: Detailed Action

Response to Arguments

1.   The Declaration filed on December 6, 2000 under 37 CFR 1.131 has been

considered but is ineffective to overcome the Hansen US 6509974 reference.

2.   The Hansen US 6509974 reference is a U.S. patent or U.S. patent application

publication of a pending or patented application that claims the rejected invention. An

affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is

claiming the same patentable invention, see MPEP § 2306. If the reference and this

application are not commonly owned, the reference can only be overcome by

establishing priority of invention through interference proceedings. See MPEP Chapter

2300 for information on initiating interference proceedings. If the reference and this

application are commonly owned, the reference may be disqualified as prior art by an

affidavit or declaration under 37 CFR 1.130. See MPEP § 718.

3.   The evidence submitted is insufficient to establish a reduction to practice of the

invention in this country or a NAFTA or WTO member country prior to the effective date

of the Hansen US 6509974 reference.

4.   Applicant has not, to the examiners satisfaction, shown that the instant

application was reduced to practice prior to May 17, 2000, the effective date of the

Hansen US 6509974 reference. Applicant has simply provided a general background

and summary of alleged support for his submission that the instant application was
reduced to practice prior to the effective filing date of the cited prior art. Therefore, the
evidence submitted is not enough to show that the instant application was reduced to
practice prior to May 17, 2000. The Applicant does not show facts supporting
completion of the invention as claimed. The grounds for rejection are therefore
maintained.

5.   The evidence submitted is insufficient to establish a conception of the invention
prior to the effective date of the Hansen US 6509974 reference. While conception is the
mental part of the inventive act, it must be capable of proof, such as by demonstrative
evidence or by a complete disclosure to another. Conception is more than a vague idea
of how to solve a problem. The requisite means themselves and their interaction must
also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417
(D.C. Cir. 1897).

6.   Applicant has simply provided a general background and summary of the instant
application. However, there is no proof based on the evidence submitted by Applicant,
that the instant application was conceived prior to May 17, 2000.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hansen

US 6509974.

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art

under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome

either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not the

invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Hansen teaches that the stations (114) can be configured to

read many different electronic file formats (column 4, lines 26-30), which reads on

receiving an input of an application file. He teaches of different types of document

features that can be selected (column 6, lines 24-31), which reads on selecting a

preferential document-processing feature from a group of document-processing

features for a print job. Hansen also teaches of a plug in that contains a new feature or

function (column 13, lines 4-6), which reads on applying a plug-in module, for

supporting the preferential document-processing feature, to the application file.

Regarding claim 2, Hansen teaches of a print production stage (108), in which

the final form of the documents are sent to a print server (120), which is then sent to the

desired output device (122) (column 6,lines 62-67). This reads on at least a portion of

the application file using the plug-in module for the print job.

Regarding claim 3, Hansen teaches of ready for printer file format, which include

Portable Format Document (PDF), Postscript and printer control language (PCL)

(column 4, lines 34-38), which reads on a page description language file selected from

the group consisting of a Portable Format Document (PDF), Postscript and printer

control language (PCL).

Regarding claim 4, Hansen teaches that a ready for printer file format is

interpreted by the internal processing engine of the print engine and converts non-ready

for printer file formats into ready for printer file format (column 5,lines 22-37), which

reads on determining whether or not the application file represents a page description

language file; converting the received application file into a page description language

file if the received application file does not represent a page description file.

Regarding claim 5, Hansen teaches of a desktop (302) that is structured as a

plug in architecture, which allows enhancements and updates (column 12, lines 62-67

and column 13, lines 1-4), which reads on accessing a plug-in module database to retrieve the selected plug-in module.

Regarding claim 6, Hansen teaches that the stations (114) can be configured to read many different electronic file formats (column 4, lines 26-30), which reads on receiving an input of an application file. He teaches the internal processing engine of the print engine and converts non-ready for printer file formats into ready for printer file format (column 5,lines 22-37), which reads on converting the application file into a page description language file if the application file is in a format distinct from the page description language file format. He teaches of different types of document features that can be selected (column 6, lines 24-31), which reads on selecting a preferential document-processing feature from a group of document-processing features for a print job. Hansen also teaches the job preparation station (116) prints the job (column 5, lines 59-62), which reads on printing the page description language file using the selected plug-in module for a print job.

Regarding claim 7, claim 7 is rejected for the same reasons as claim 3.

Regarding claim 8, claim 8 is rejected for the same reasons as claim 5.

Regarding claim 9, Hansen teaches of an internal processing engine that interprets whether a file is a ready for printer file format or not (column 5, lines 22-44), which reads on a detector for receiving an input of an application file and determining whether the application file represents a page description language file. He teaches of a GUI interface represented on workstation (116) that allows manipulation of documents (column 8,lines 59-67 and column 9,lines 1-5), which reads on a user interface for

selecting a preferential document-processing feature from a group of document-processing features. Hansen also teaches that the prepared documents are submitted to a production output device (122) (column 8,lines 37-40), which reads on printer for applying a plug-in module, associated with the preferential document-processing features, to the application file.

Regarding claim 10, Hansen teaches of RIP'ing (Raster Image Processor) a job prior to being sent to a device (122) (column 7, lines 7-10), which reads on a bitmap printing module for printing the application file.

Regarding claim 11, claim 11 is rejected for the same reasons as claim 3

Regarding claim 12, Hansen teaches that the computer automatically converts the documents into a ready for printer format file (column 2,lines 39-41), which reads on a converter for converting the application file to a page description language file if the application file does not represent a page description language file.

Regarding claim 13, Hansen teaches the print server (120) detects the attributes of the job (column 18,lines 29-32), which reads on a customization detector configured to detect whether customization data is associated with the application file. Hansen shows that the print server (120) and workstation (116), which reads on plug-in selector, where the desktop (302) is located are connected (figures 1a and 1b), which reads on the plug-in selector in communication with the customization detector and the plug-in database for selecting an active plug-in module based on the customization data.

Regarding claim 14, Hansen teaches of an internal processing engine that interprets whether a file is a ready for printer file format or not (column 5, lines 22-44),

which reads on a detector for receiving an input of an application file and determining

whether the application file represents a page description language file. Hansen

teaches of workstation (116), which provides the ability to modify documents (column 6,

lines 20-31), which reads on a data augmenter for associating a preferential document-

processing feature with the application file. Hansen also teaches of a desktop (302),

which selects plug-ins (column 12, lines 62-67 and column 13, lines 1-9), which reads

on a plug-in selector for selecting a plug-in module for supporting the document-

processing feature.

Regarding claim 15, teaches of a production output device (122) such as a

printer (column 7,lines 46-48), which reads on a printer for printing the application file

using the selected plug-in module.

Regarding claim 16, claim 16 is rejected for the same reasons as claim 3

Regarding claim 17, claim 17 is rejected for the same reasons as claim 12

Regarding claim 18, Hansen teaches of a desktop (302) in which a main program

code looks for plug-ins (column 12, lines 62-67 and column 13, lines 1-9), which reads

on the plug-in selector is adapted to access a plug-in database to retrieve the selected

plug-in module.

Regarding claim 19, Hansen teaches of a file downloader used by the production

output device (122) (column 8, lines 36-40 and figures 1a and 1b), which reads on the

data augmenter cooperates with a downloader to express the preferential document-

processing feature as a downloader-embedded customization data in the application

file.

Regarding claim 20, Hansen teaches that the job is sent from the job preparation

stations (116) to the production output devices (122) to be printed (column 6,lines 1-3

and column 11,lines 53-55). It is inherent that the production output device (122)

contains a printer driver because it prints the job sent by the job preparation station

(116), which reads on the data augmenter cooperates with a printer driver to express

the preferential document-processing feature as printer-driver-embedded customization

data in the application file.

Conclusion

3.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time
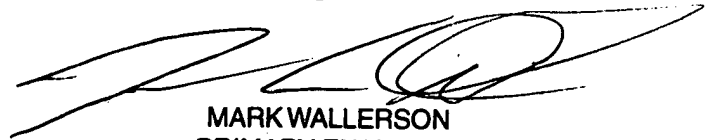
policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

1.   Any inquiry concerning this communication should be directed to Michael

Burleson whose telephone number is (571) 272-7460 and fax number is (571) 273-

7460. The examiner can normally be reached Monday thru Friday from 8:00 a.m. –

4:30p.m. If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Kimberly Williams can be reached at (571) 272-7471.

Michael Burleson
Patent Examiner
Art Unit 2626

MARK WALLERSON
PRIMARY EXAMINER

Mlb
May 26, 2005